

REMARKS

This responds to the Office Action mailed on March 24, 2004.

Claims 9 and 10 are amended, no claims are canceled, and no claims are added; as a result, claims 1-32 are now pending in this application.

As a preliminary matter, Applicant respectfully traverses the finality of the pending rejection. At the time of the pending Office Action, claims 1-32 were pending with claims 1-10 being considered by the Examiner. The pending Office Action does not appear to provide action on the merits of claims 1-8, which should remain under consideration by the Examiner until an election is made by the Applicant. Pursuant to MPEP §810, “if an action is given on the merits, *it must be given on all claims* (emphasis in original)”

Reconsideration and withdrawal of the finality of the pending Office Action is respectfully requested.

Affirmation of Election

The pending office action states that “claims 11-26 continue to stand as being withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.”

The pending office action further states that “this application contains claims directed to the following patentably distinct species of the claimed invention.”

Species A, drawn to rolling a mandrel with trace conductive material in a single revolution, Claims 9-10;

Species B, drawn to rolling a mandrel with trace conductive material in more than one revolution, Claims 1-8 and 31;

Species C, drawn to a mandrel that includes coaxial conductors, Claims 27-29;

Species D, drawn to forming disk shaped windings, Claim 30; and

Species E, drawn to forming cone shaped windings, Claim 32.

Because claims 9-10 appear to be the only claims examined, Applicant has no choice but to provisionally elect species A, drawn to claims 9-10. Applicant respectfully traverses the restriction.

Applicant respectfully traverses the characterization of species A. The restriction states that claims 9-10 are drawn to “rolling a mandrel with trace conductive material in a single revolution.” For example, Applicant is unable to find the limitation of a “single revolution” in claims 9-10.

Applicant also respectfully traverses the characterization of species B. The restriction states that claims 1-8 and 31 are drawn to “rolling a mandrel with trace conductive material in more than one revolution.” For example, Applicant is unable to find a “mandrel” in claim 1.

§102 Rejection of the Claims

Claim 9 was rejected under 35 USC § 102(b) as being anticipated by Weatherly, U.S. Patent No. 4,639,708. Applicant respectfully traverses the rejection for at least the following reasons.

The rejection states that Weatherly shows “rolling the film around a mandrel.” Weatherly appears to show wrapping a sheet 10 around an electrically insulating hollow cylindrical core 22 (Col. 2, lines 13-15). However, Applicant is unable to find in Weatherly attaching an end of the film to a mandrel, and rolling the mandrel with the film attached such that when rolled the end of the film is pulled, and the trace of conductive material circumferentially wraps around a longitudinal axis of rolling. In contrast, claim 9 as amended includes attaching an end of the film to a mandrel, and rolling the mandrel with the film attached such that when rolled the end of the film is pulled, and the trace of conductive material circumferentially wraps around a longitudinal axis of rolling.

Because the Weatherly reference does not show every element of Applicant's independent claims, a 35 USC § 102(b) rejection is not supported. Reconsideration and withdrawal of the rejection are respectfully requested with respect to Applicant's independent claim 9. Additionally, reconsideration and withdrawal of the rejection are respectfully requested with respect to claim 10 that depends therefrom.

Claim 9 was rejected under 35 USC § 102(b) as being anticipated by McGaffigan, U.S. Patent No. 5,526,561. Applicant respectfully traverses the rejection for at least the following reasons.

The rejection states that McGaffigan shows rolling a film about a mandrel 92 such that a trace of conductive material is circumferentially wrapped around a longitudinal axis. McGaffigan appears to show winding a braid 96 around a mandrel 92 (col. 7, lines 13-14). McGaffigan also appears to show an embodiment in Figures 12-13 where “no soldering is required” (col. 7, lines 31-33). McGaffigan does not show attaching an end of the film to a mandrel, and rolling the mandrel with the film attached such that when rolled the end of the film is pulled, and the trace of conductive material circumferentially wraps around a longitudinal axis of rolling. In contrast, claim 9 as amended includes attaching an end of the film to a mandrel, and rolling the mandrel with the film attached such that when rolled the end of the film is pulled, and the trace of conductive material circumferentially wraps around a longitudinal axis of rolling.

Because the Weatherly reference does not show every element of Applicant's independent claims, a 35 USC § 102(b) rejection is not supported. Reconsideration and withdrawal of the rejection are respectfully requested with respect to Applicant's independent claim 9. Additionally, reconsideration and withdrawal of the rejection are respectfully requested with respect to claim 10 that depends therefrom.

§103 Rejection of the Claims

Claim 10 was rejected under 35 USC § 103(a) as being unpatentable over Weatherly, U.S. Patent No. 4,639,708 in view of McGaffigan, U.S. Patent No. 5,526,561.

Applicant respectfully submits that the combination of Weatherly and McGaffigan also fail to anticipate claim 10 for at least the following reasons. The rejection states that “McGaffigan in an alternative embodiment, shows affixing a soldering attaching trace at the ends of the conductive traces to solder the ends of the traces on the mandrel.” McGaffigan appears to show soldering ends 16 and 18 to copper bands 8 (col. 3, lines 62-64). However, McGaffigan does not show rolling a mandrel with a film attached such that when rolled an end of the film is pulled. McGaffigan also does not show soldering the attaching trace to a *mandrel*.

Because the cited references, either alone or in combination, do not show every element of Applicant's independent claims, a 35 USC § 103(a) rejection is not supported by the references. Reconsideration and withdrawal of the rejection are respectfully requested with respect to claim 10.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6944 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By his Representatives,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20th day of July, 2004.

 

Name

Signature